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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,447	01/22/2002	James R. Keogh	P0009170.00	5485
27581	7590	09/08/2008		
MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MINNEAPOLIS, MN 55432-9924			EXAMINER BAGOPIAN, CASEY SHEA	
			ART UNIT 1615	PAPER NUMBER
			MAIL DATE 09/08/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/054,447

**Applicant(s)**

KEOGH ET AL.

**Examiner**

Casey S. Hagopian

**Art Unit**

1615

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 10, 233, 273-275, 279-281 and 293-296 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4, 275 and 295 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

Receipt is acknowledged of applicant's Amendment/Remarks filed 6/9/2008.

It is acknowledged and looked favorably upon that applicant has taken the substance of the interview dated 6/18/2008 into consideration. It is with regret that the examiner must make new rejections based on some of the suggestions the examiner made in said interview. Accordingly, the instant office action is made Non-final.

Claims 4, 10, 275, 280, 281 and 295 have been amended. Claims 9, 11-232, 234-272, 276-278, 282-292 and 297-298 have been cancelled. Claims 1-8, 10, 233, 273-275, 279-281 and 293-296 are currently pending.

#### **MAINTAINED REJECTIONS**

No objections/rejections have been maintained from the previous Office Action dated 3/19/2008. All previous objections/rejections have been withdrawn.

#### **NEW OBJECTIONS/REJECTIONS**

After further consideration, the following new objections/rejections have been added:

##### ***Specification***

The amendment filed 6/9/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material

which is not supported by the original disclosure is as follows: the generic term cobalt-chromium alloys.

Applicant is required to cancel the new matter in the reply to this Office Action.

The use of the trademarks ELGILOY, HAYNES 25 and STELLITE have been noted in this application. They should be capitalized wherever it appears and be accompanied by their generic terminology. Please note that "cobalt-chromium alloys" is not specific enough. Each trademark ELGILOY, HAYNES 25 and STELLITE are different metals with different compositions and this should be reflected in the statements of generic terminology for each individual trademark. Further, it is requested that applicant submit evidence of the generic terminology of each trademark because after a cursory search, the examiner is unable to determine whether ELGILOY, HAYNES 25 and STELLITE are in fact cobalt-chromium alloys.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4, 275 and 295 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject

matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a new matter rejection.** There is no teaching of all cobalt-chromium alloys; the subject matter is not properly described as filed. The term "a cobalt-chromium alloy" in said claims is defined to include "Elgiloy®, haynes 25 and stellite" as described in the newly amended specification at page 25, lines 8-26. After a cursory search, the examiner is unable to determine whether "Elgiloy®", "haynes 25" and "Stellite" are in fact cobalt-chromium alloys. However, even if "Elgiloy®, haynes 25 and stellite" are all considered cobalt-chromium alloys, applicant did not have possession of the entire genera of cobalt-chromium alloys. Applicant only had possession of the presumed "cobalt-chromium alloys" "Elgiloy®, haynes 25 and stellite", thus it is suggested that applicant replace "cobalt-chromium alloys" with the particular generic terminology of each "Elgiloy®, haynes 25 and stellite". Further, it is requested that applicant submit evidence of the generic terminology of each "Elgiloy®, haynes 25 and stellite".

### ***Conclusion***

Claims 4, 275 and 295 have been rejected. Claims 1-8, 10, 233, 273-275, 279-281 and 293-296 appear to be free of the art. Pending a patentability conference and the corrections the examiner has suggested, the claims may be allowable.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Casey Hagopian whose telephone number is 571-272-6097. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's mentor, Carlos Azpuru, can be reached at 571-272-0588 or the examiner's supervisor, Michael Woodward, can be reached at 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Casey S Hagopian/

Examiner, Art Unit 1615

/Carlos A. Azpuru/

Primary Examiner, Art Unit 1615